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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,658	04/02/2004	Shinichiro Iwata	K2635.0078	8203

7590 01/18/2007  
Dickstein Shapiro Morin & Oshinsky LLP  
41st Floor  
1177 Avenue of the Americas  
New York, NY 10036-2714

EXAMINER
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NGUYEN, CHAU T

ART UNIT	PAPER NUMBER
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2176

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/18/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/815,658

Applicant(s)

IWATA, SHINICHIRO

Examiner

Chau Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/26/2006</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Amendment filed on 10/26/2006 has been entered. Claims 1-6 are presented for examination.

#### ***Information Disclosure Statement***

2. The information disclosure statement filed 10/26/2006 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto, JP Patent No. JP 11328181 A, Hayashi, JP Patent No. JP 10222501 A further in view of Moughanni et al. (Moughanni), US Patent No. 5,675,817.

5. As to dependent claim 1, Matsumoto discloses a method of displaying an electronic message, comprising: receiving an electronic message including a sentence as a conversion object sentence in a reception mode (Matsumoto, pages 1-2: a sentence is inputted for translation; automatically converts each of character string to produce a mixed sentence; and displaying said mixed sentence (KANA/KANJI conversion is performed and the inputted sentence is turned to a KANJI/KANA mixed sentence, and the mixed sentence is displayed).

However, Matsumoto does not disclose the mixed sentence is pictograph mixed sentence and the pictograph corresponding to said character string is defined. Hayashi discloses an animation database stores the data of animation image about a character, retrieving a character that is inputted with a conversion operation, then converting it into a corresponding candidate character into an animation image (pictograph mixed sentence) (Hayashi, page 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Hayashi and Matsumoto to include pictograph mixed sentence and the pictograph corresponding to said character string is defined since Hayashi provides a character converter which does not only simply perform character conversion but also has various conversion functions.

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However, Matsumoto and Hayashi do not explicitly disclose the electronic message is an electronic mail.

Moughanni discloses a user of a pager receiving an electronic message (electronic mail) in a language of their own choice and the message (mail) is translated to a default language of the user (Abstract).

Since Moughanni discloses translating or converting a language to a different one, which is similar to language conversions of Matsumoto and Hayashi, thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Moughanni and Matsumoto and Hayashi to include an electronic mail as an input sentence in one language and converting it to another language of the default of the user device thus it provides a user-friendly environment for foreign people.

6. As to dependent 2, Matsumoto, Hayashi, and Moughanni disclose specifying one of said pictographs of the displayed pictograph mixed sentence; determining a specific character string corresponding to said specific pictograph; and displaying said specific character string (Hayashi, page 1: Hayashi discloses an animation database stores the data of animation image about a character, retrieving a character that is inputted with a conversion operation, then converting it into a corresponding candidate character into an animation image (pictograph mixed sentence) (Hayashi, page 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Hayashi and Matsumoto to include

pictograph mixed sentence and the pictograph corresponding to said character string is defined since Hayashi provides a character converter which does not only simply perform character conversion but also has various conversion functions).

7. As to dependent claim 3, Matsumoto, Hayashi, and Moughanni disclose wherein said displaying includes: displaying said pictograph mixed sentence and said specific character string at a same time (Matsumoto, pages 1-2: Kanji/Kana mixed sentence is displayed; Hayashi discloses in page 1: retrieving a character that is inputted with a conversion operation, then converting it into a corresponding candidate character into an animation image (pictograph mixed sentence), and the motivation for combine Hayashi and Matsumoto is that Hayashi provides a character converter which does not only simply perform character conversion but also has various conversion functions).

8. As to dependent claim 4, Matsumoto, Hayashi, and Moughanni disclose inputting a sentence in a transmission mode; converting a specified one of character strings of said inputted sentence a specific pictograph corresponding to said specified character string, to produce a pictograph mixed inputted sentence; and displaying said pictograph mixed inputted sentence (Matsumoto, pages 1-2: a sentence is inputted for translation; automatically converts each of character string to produce a mixed sentence; and displaying said mixed sentence (KANA/KANJI conversion is performed and the inputted sentence is turned to a KANJI/KANA mixed sentence, and the mixed sentence is displayed).

However, Matsumoto does not disclose the mixed sentence is pictograph mixed sentence and the pictograph corresponding to said character string is defined. Hayashi discloses an animation database stores the data of animation image about a character, retrieving a character that is inputted with a conversion operation, then converting it into a corresponding candidate character into an animation image (pictograph mixed sentence) (Hayashi, page 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Hayashi and Matsumoto to include pictograph mixed sentence and the pictograph corresponding to said character string is defined since Hayashi provides a character converter which does not only simply perform character conversion but also has various conversion functions).

9. As to dependent claim 5, Matsumoto, Hayashi, and Moughanni disclose transmitting said pictograph mixed inputted sentence in said transmission mode (Matsumoto, pages 1-2; Hayashi discloses in page 1: retrieving a character that is inputted with a conversion operation, then converting it into a corresponding candidate character into an animation image (pictograph mixed sentence), and the motivation for combine Hayashi and Matsumoto is that Hayashi provides a character converter which does not only simply perform character conversion but also has various conversion functions).

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10. As to dependent claim 6, Matsumoto, Hayashi, and Moughanni disclose wherein said inputted sentence is a Kana sentence, said method further comprises: converting each of specified ones of Kana character strings of said inputted sentence into Kanji characters in said transmission mode (Matsumoto, page 1).

### ***Response to Arguments***

In the remarks, Applicant(s) argued in substance that

A) "When an application is a divisional application filed under 37 C.F.R. § 1.53(b), an Applicant need not resubmit copies of the documents made of record in the present application. See M.P.E.P.609.02.

In reply to argument A, the foreign patent documents JP-6-96056, JP-9-325958, JP-10-98544, JP-9-146938, JP-2000-299699, JP-2000-102048, and JP-2001-56791 are submitted in Japanese language. At least abstracts of these foreign patent documents should be translated into English so Examiner would be able to consider them (All content requirements of 37 CFR 1.98. See MPEP). However, these foreign patent documents are in Japanese language, therefore Examiner could not consider them.

In addition, these foreign patent documents were also filed in the application 09/727679 (Patent # 6839877), and the previous Examiner, who examined the application 09/727679, did not consider these foreign patent documents as well.



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B) "As the present application was filed as a result of the restriction requirement in Iwata, Iwata cannot be used as a ground for a rejection in the present case, including that of non-statutory obviousness-type double patenting."

In reply to argument B, the double patenting is now withdrawn.

C) "Hayashi does not teach a device that converts a character string into a pictograph in said reception mode, and hence cannot combined with Matsumoto to render obvious a pictograph mixed sentence when said pictograph corresponding to said character string is defined," and " there is no motivation, teaching, or suggestion for combining Matsumoto with Hayashi."

In reply to argument C, applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Matsumoto discloses receiving an electronic message including a sentence as a conversion object sentence in a reception mode ((Matsumoto, pages 1-2: a sentence is inputted for translation; automatically converts each of character string to produce a mixed sentence; and displaying said mixed sentence (KANA/KANJI

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conversion is performed and the inputted sentence is turned to a KANJI/KANA mixed sentence, and the mixed sentence is displayed).

However, Matsumoto does not disclose the mixed sentence is pictograph mixed sentence and the pictograph corresponding to said character string is defined. Hayashi discloses an animation database stores the data of animation image about a character, retrieving a character that is inputted with a conversion operation, then converting it into a corresponding candidate character into an animation image (pictograph mixed sentence) (Hayashi, page 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Hayashi and Matsumoto to include pictograph mixed sentence and the pictograph corresponding to said character string is defined since Hayashi provides a character converter which does not only simply perform character conversion but also has various conversion functions.

D) Moughanni does not teach or suggest receiving electronic mail.

In reply to argument D, Moughanni discloses a user of a pager receiving an electronic message (electronic mail) in a language of their own choice and the message (mail) is translated to a default language of the user (Abstract).

11. Applicant's arguments filed 10/26/2006 have been fully considered but they are not persuasive. Please see the rejection and respond to arguments above.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau Nguyen whose telephone number is (571) 272-4092. The examiner can normally be reached on 8:30 am – 5:30 pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. On July 15, 2005, the Central Facsimile (FAX) Number will change from 703-872-9306 to 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chau Nguyen  
Patent Examiner  
Art Unit 2176



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